

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 5, 2005 ("Office Action"). Claims 1-26 currently stand rejected.

Section 103(a) Rejections

The Office Action rejects Claims 1-5, 7-9, 11-18 and 20-26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,095,419 issued to Seki et al. ("Seki"), in view of U.S. Patent No. 5,819,338 issued to Salm ("Salm"). Applicant respectfully traverses these rejections for the reasons stated below.

Independent Claim 1 is allowable because the proposed combination of *Seki* and *Salm* fails to disclose, teach or suggest determining, by a computer, information regarding one or more inserts for the die plates based on one or more operations of one or more processes needed to form the features in the part. With regards to this limitation, the Office Action merely points to Column 2, Lines 55-60 ("First Portion") and Column 3, Lines 55-62 ("Second Portion") of *Seki*. But, this is incorrect. The entirety of the First Portion and the Second Portion are as follows:

Numeral 11a denotes a processor, 11b a ROM, 11c a RAM, 12 a graphic display unit, 13 a tablet device, 14a a keyboard, 14b an X-Y plotter, and 15 a mass storage device which stores various data files for progressive mold design, as well as automatically created NC information, etc.

(Column 2, Lines 55-60.)

(a) Blank layout design is carried out based on the entered article shape. Next, in strip layout design, the different shapes, such as the shapes of the dies (punches) DF1-DF3 are defined at predetermined positions of the plate, and these are stored in the RAM 11c as data d1-d3. The defined die shapes (punch shapes) DF.sub.1 -DF.sub.3 are displayed on the display screen (see FIG. 1).

(Column 3, Lines 55-62.) Clearly neither the First Portion nor the Second Portion disclose determining, by a computer, information regarding one or more inserts, *let alone* determining *based* on one or more operations of one or more processes needed to form the features in the part. Applicant is unable to locate any other disclosure in *Seki* or *Salm* that teaches this limitation. Accordingly, for at least this reason, Applicants submit that Independent Claim 1 and its dependents, Claims 2-6 are allowable. Independent Claims 9, 14, and 22 and their dependents, Claims 10-13, 15-21 are allowable for analogous reasons.

Notwithstanding the above reasons for allowance, many of the dependent claims are also allowable because the combined references fails to teach or suggest the additional limitation or limitations recited by respective dependent claims. Examples are described below.

Claim 2 is allowable because the combined references fail to disclose, teach, or suggest determining, by a computer, one or more processes needed to form the features in the part *and* determining, by the computer, the one or more operations associated with each process. With regards to these limitations, the Office Action merely points to portions of *Salm*, namely Column 2, Lines 20-32, Column 2, Lines 45-55, and Column 5, lines 50-60. However, this is incorrect. These portions generally describe a process whereby a 3-D model for a prototype workpiece is segmented into pieces, not determining, by a computer, one or more processes needed to form the features in the part *and* determining, by the computer, the one or more operations associated with each process. For at least this additional reason, Claim 2 is allowable. Independent Claims 9 and 22 and their dependents, Claims 12-13 and 23-24 are allowable for analogous reasons.

Claim 3 is allowable because the combined references fail to disclose, teach, or suggest simulating, by a computer, the operations of each process on the strip. With regards to this limitation, the Office Action, once again, merely points to portions of *Salm*, namely Column 2, Lines 20-32, Column 2, Lines 45-55, and Column 5, lines 50-60. However, this is incorrect. Once again, these portions generally describe a process whereby a 3-D model for a prototype work piece is segmented into pieces, not simulating, by a computer, the operations of each process on the strip. For at least this additional reason, Claim 3 is allowable. Independent Claims 9 and 22 and their dependents, Claims 12-13 and 23-24 are allowable for analogous reasons.

Applicant additionally challenges the Office Action's alleged motivation to combine and modify features from the proposed references. The entirety of this alleged motivation is as follows:

... it would have been obvious to a person of ordinary skill in the art to modify the above invention suggested by Seki et. al and combining it with the invention disclosed by *Salm*. The results of this combination would lead to computer-aided die design system and method. One of ordinary skill in the art would have been motivated to do this modification in order to prepare

an object utilizing a computer on the basis of geometric description as suggested by Salm.

(Office Action, Page 3.) This conclusory reasoning falls short of the required evidence of a motivation to combine and/or modify prior art references. *See Ex Part O'Donnell*, Appeal No. 2004-0421 (The Board found that the Examiner's reason, "it would have been within the scope of one of ordinary skill in the art to combine the teachings of [the references] to achieve further corrosion resistance," an inadequate reason as to why there is a motivation to combine the references.). Undeniably, a substantial modification of the references would need to be undertaken because *Salm* has nothing to do with progressive die design. Rather, *Salm* is directed towards production of a prototype work piece by breaking down the piece down into segments. It appears that the Office Action utilizes *Salm* merely for the fact that it mentions "3-D" and "computer". But, this is clearly not enough.

A reminder is given that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g., In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt."). Further, "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). "[An] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* Furthermore, simple hindsight speculation that "it would have been obvious" to make the proposed combination is insufficient under M.P.E.P.¹ guidelines and governing Federal Circuit case law.² Moreover, such statements and assumptions are

¹ *See, e.g.*, M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”³

Should a rejection based on any of the above asserted rejections be maintained, Applicant respectfully requests appropriate evidentiary support. Additionally, if the Examiner is relying upon “common knowledge” or “well known” principles to establish the rejection, Applicant requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an “Official Notice” or other information within the Examiner’s personal knowledge, Applicant respectfully requests that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

The Office Action also rejected Claims 6, 10 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Seki* in view of *Salm* and in further view of U.S. Patent No. 5,819,338 issued to Maeda et al. (“*Maeda*”). These rejections are moot because the Independent Claims are allowable as described above.

¹ 175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).

³ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

